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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/733,619

12/10/2003

Ellen Lasch

37355-202

8507

7590

11/17/2004

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EXAMINER

WALSH, DANIEL I

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,619

Applicant(s)

LASCH ET AL.

Examiner

Daniel I Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10-04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Receipt is acknowledged of the IDS received on 18 October 2004.

Claim Objections

2. Claim 7 objected to because of the following informalities: Replace "mans" with -- means -- .

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claims 1-17, the use of the term "transaction card" renders the claim vague/indefinite, as it is unclear what a transaction card is, because it appears to the Examiner that PCMCIA cards, electronic/magnetic cards, and paper (non electronic/magnetic) cards can be characterized as transaction cards, and that indeed PCMCIA cards can be folded (see US 6,032,866).

Appropriate clarification/correction is required.

Re claims 15-17, the use of "a magnetic stripe" as "electronic storage means" renders the claims vague/indefinite, as magnetic stripes are not the same as electrical chips, for example.

Accordingly, the Examiner notes that if the Applicant wishes to have claims drawn to electronic chip cards and magnetic cards, a restriction will be enforced.

Appropriate correction/clarification is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-2, 13, 14-17 and 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda (US 5,004,899).

Re claims 1-2, Ueda teaches a foldable transaction card with first and second sections hingably attached (FIG. 1a+). Ueda is silent to a housing surrounding the card with a hinge for folding the housing. The Examiner notes that hinged boxes, wallets, purses, organizers, etc. for example, are well known and conventional for holding secure items, such as cards. Simply

reciting a housing for a card it therefore obvious and conventional in the art, and as claimed, the housing is not integral to the card. Simply specifying a housing with a hinge that surrounds the card when folded, is obvious, as a means to removably hold the card (see US 4,884,507). The Examiner notes that it is well known that a folded card can be put in the pocket/sleeve of a wallet, for example, in a folded position, whereby when the wallet/housing is opened, the card is able to be unfolded. Further, the Examiner notes its well-known and conventional for magnetic stripes to be disposed on a card, in addition to or in place of IC chips, depending on the desired application/functionality/storage, and that such modification is obvious in the art for those reasons. Further, depending on how the card and wallet/housing are manipulated, it is obvious that the card can be read both while it still remains in the wallet/housing (by folding parts of the wallet while still keeping the card disposed therein, and also by simply removing the card).

5. Claims 1, 3, 4, 5, 6, 9, 10, 13, and 14 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Hooglander et al. (US 20020166897).

Hooglander et al. teaches the claimed limitations via FIG. 1a+. Though Hooglander et al. is silent to separate housing/cards as Hooglander et al. teaches an integral structure, the Examiner notes that it would have been obvious to an artisan of ordinary skill in the art to form the device in parts as it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177,179. Additionally, the Examiner alternatively notes (re claim 1) that the claim simply recites a hinged housing for the card. Hinged housings (storage means) for cards are well known and conventional in the art (see below for example).

6. Claims 3-6, 13, 14, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda, in view of Hileman et al.

The teachings of Ueda have been discussed above. Re claim 18, a fold line is taught via FIG. 1a. Re claim 19, Ueda teaches a strip 3 connected to first and second sections.

Ueda is silent to a card attached to the housing, and that the housing has a first and second section attached via a hinge, where the first section of the card is attached to the first section of the housing.

Hileman et al. teaches a housing surrounding a transaction card and a hinge for folding the housing (FIG. 1 – FIG. 2), and that a first section of a card is attached to a first section of a housing. Hileman et al. teaches the card is attached for shipping/handling with adhesive 34, which is removably disposed (re claim 2). Reader hinge 26 is disposed between first and second housing sections (re claim 4). Re claim 13, the Examiner notes that depending on how the card is disposed in the reader in the open position, it is obvious that the card can unfold out of the housing, depending on how its packaged during shipping. Re claim 14, the second section comprises an electronic storage means (1,7) for storing information that is readable with an electronic reader.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Ueda with those of Hileman et al.

One would have been motivated to do this to transport a card while also protecting its components by folding it.

7. Claims 3-14, 18, and 19 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda, in view of Middlemiss et al. (US 6,184,788).

The teachings of Ueda have been discussed above. Re claim 18, a fold line is taught via FIG. 1a. Re claim 19, Ueda teaches a strip 3 connected to first and second sections.

Ueda is silent to a card attached to the housing, and that the housing has a first and second section attached via a hinge

Middlemiss et al. teaches a housing surrounding a transaction card, a hinge for folding the housing (FIG. 1+), and that a first section of the card is attached to a first section of a housing. Middlemiss et al. teaches the card is removably disposed (re claim 2) through tracks/pockets 8, also interpreted as attaching means (removable). A hinge is disposed between first and second housing sections (FIG. 2+). Re claims 7-8, the attaching means for removably removing the card from the track have been discussed above. Re claims 9-12, the Examiner notes that Middlemiss et al. teaches opening means (FIG. 2), but is silent to an actuator/button allowing the housing to open and a spring-loaded hinge. However, the Examiner notes that actuators/buttons to open a housing are well known and conventional in the art (see the teachings of Levy below). Using spring loaded hinges to spring open the housing when its open, is well known and conventional in the art (see US 5,221,024), and is an obvious expedient, especially in light of FIG. 6, where it is clearly obvious that an actuator to open the housing and to spring it open so that the contents are visible (cards) is well within the skill in the art, to produce the expected results of opening a housing mechanism, via button actuated means, and springing open the housing via hinges, which are both well known and conventional in the art, to see the cards without the housing closing back down, or having the extra step of manually opening the housing.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Hileman et al. with those of Ueda.

One would have been motivated to do this to transport a card while also protecting its components by folding it.

8. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda, in view of Levy (US 4,84507).

The teachings of Ueda have been discussed above.

Ueda is silent to an opening means to access the card in the housing, that the opening means comprises an actuator, that the spring loadable hinge allows the housing to spring open when opened.

Levy teaches such limitations (FIG. 1+) except for the spring loading of the hinge.

However, the Examiner notes that spring loaded hinges to spring holding devices open when the device is opened, is well known and conventional in the art (see US 5,221,024), as a matter of convenience, so that the holding devices do not close when the contents are being viewed/manipulated. Accordingly, simply applying spring-loaded hinges to the teachings of Levy would have been an obvious expedient, to add to the convenience of the holding device for the user.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Ueda with those of Levy et al.

One would have been motivated to do this to have a holding device to hold cards.

9. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda, in view of Pentz et al. (US 6,471,127).

The teachings of Ueda have been discussed above.

Ueda is silent to the dimensions of the unfolded card being smaller than a traditional transaction card.

Pentz et al. teaches a reduced sized data/credit card (abstract and FIG. 9B, for example).

At the time the invention was made, it would have been obvious to an artisan to combine the teachings of Ueda with those of Pentz et al.

One would have been motivated to do this to further reduce the size of the card for ease of carrying/convenience, by reducing its overall size, while still being able to read the card.

Accordingly, the examiner notes that the reduction in size of a card is obvious to one of ordinary skill in the art not only to reduce the burden on the owner of the card, but also to reduce material costs and present an aesthetically pleasing shape, or size, while still retaining full functionality. Creating a smaller, folder card, therefore is obvious in light of the prior art to provide a card that is smaller for convenience and reduction of cost/materials, therefore producing expected results.

10. Claim 20 is alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda, in view of Weyant.

The teachings of Ueda have been discussed above.

Ueda is silent to a dimension of the unfolded card being smaller than a traditional transaction card.

Weyant teaches such limitations (abstract). Additionally the Examiner notes it's well known and conventional to have foldable cards smaller than traditional cards in the unfolded position (see Keller US 5,700,037).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Ueda with those of Weyant.

One would have been motivated to do this to reduce the dimension for convenience.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Hooglander (US 2002/0166897, US 2001/0045469, US 6,651,892, US 6,419,158, Des. 432,939), Lasch et al. (US 2004/0144846 2004/0089724), Shriver (US 6,065,674), Knighton et al. (US 6,032,866), Koshida et al. (US 6,013,345), Kokubu (US 5,710,421), Keller (US 5,700,037), Ueda (4,849,617), Drexler (US 4,917,292), Solo (US 4,801,790 and 4,562,342), Oshikoshi et al. (US 4,768,811), Meyer (US 6,460,696), Barnes (US 4,937,963), Reis (US 3,929,177), Vallans et al. (US 6,651,813), Andersen et al. (US 5,665,439), Levy (US 4,884,507), Birch, Sr. (US 5,311,679), Kass-Pious (US 4,897,947), Gamm (US 4,697,363), Luu (US 6,766,952), Nelms et al. (US D474,234), Sakamaki et al. (US 6,128,604), Kaminski (US 6,082,422), Jones et al. (US 2003/0047482), and Hosono (JP361100436A).

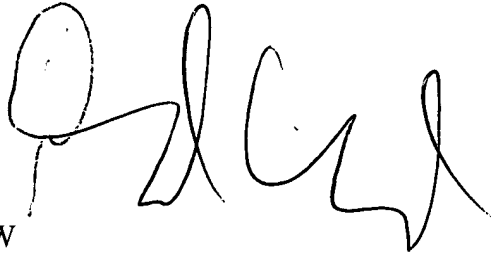
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone numbers for this Group is (703) 308-7722, (703) 308-7724, or (703) 308-7382.

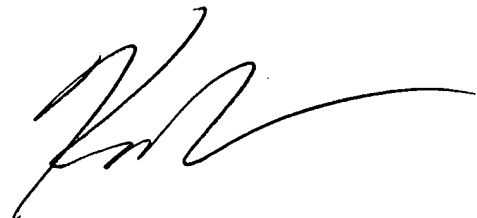
Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [daniel.walsh@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



DW
11/1/04



KARL D. FRECH
PRIMARY EXAMINER